

IN THE UNITED STATES DISTRICT COURT
FOR THE WESTERN DISTRICT OF WASHINGTON

AT SEATTLE

11 UTHERVERSE GAMING LLC,

12 Plaintiff,

13 v.

14 EPIC GAMES, INC.,

15 Defendant.

Case No. 2:21-cv-00799-RSM-TLF

**REQUEST FOR INTERNATIONAL
JUDICIAL ASSISTANCE (LETTER
ROGATORY)**

1 TO THE SUPREME COURT OF BRITISH COLUMBIA:

2 The United States District Court for the Western District of Washington presents its compliments
 3 to the Supreme Court of British Columbia and requests judicial assistance to compel the attendance of
 4 witnesses at an oral deposition in British Columbia and the production of documents to be used at trial
 5 this Court in the above-captioned matter. This Court requests the assistance described herein as
 6 necessary in the interests of justice and directs this request to the appropriate Judicial Authority in the
 7 Province of British Columbia, Canada.

8 **I. SUMMARY OF ACTION**

9 Plaintiff Utherverse Gaming LLC (“Utherverse Gaming”) filed this action against Epic Games,
 10 Inc. (“Epic”) on June 11, 2021, alleging infringement of United States Patent Nos. 8,276,071, 8,812,954,
 11 9,123,157, and 9,724,605 (collectively, the “Asserted Patents”). Utherverse Gaming alleges that Epic
 12 infringes the Asserted Patents by holding certain live virtual special events in the online video game
 13 *Fortnite*. Epic denies that it infringes the Asserted Patents and alleges that the Asserted Patents are
 14 invalid in view of various prior art and because they claim subject matter not eligible for patenting under
 15 U.S. patent law. Utherverse Gaming denies that the patents are invalid.

16 The Asserted Patents were issued between September 25, 2012 and August 8, 2017. Each of the
 17 patents was initially assigned to Utherverse Digital Inc. (“Utherverse Digital”), a British Columbia
 18 corporation headquartered in Vancouver. Utherverse Digital describes itself as “a social network of
 19 interconnected virtual worlds” that offers “opportunities for people to meet, play and work together
 20 regardless of their physical location.”¹

21 The named inventors of the ’071, ’954, and ’157 patents are Brian Shuster and Gary Shuster. The
 22 named inventors of the ’605 patent are Brian Shuster and Aaron Burch. According to disclosures
 23 provided under Federal Rule of Civil Procedure 26 in this action, Messrs. Shuster and Mr. Burch reside
 24 in British Columbia. Further, according to Utherverse Gaming’s interrogatory responses, while Brian
 25 Shuster is currently a member of Utherverse Gaming’s Board of Managers, neither Gary Shuster nor Mr.
 26 Burch currently hold or have ever held a position as Utherverse Gaming officers, directors, or managing

27
 28 ¹ <https://www.utherverse.net/index.html>
 REQUEST FOR INTERNATIONAL JUDICIAL
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1 agents.

2 Utherverse Gaming is a U.S. corporation organized under the laws of Delaware. According to its
 3 certificate of formation, attached hereto as Exhibit A-1, Utherverse Gaming was formed on October 22,
 4 2020. According to information filed with the U.S. Patent and Trademark Office, the Asserted Patents
 5 were assigned by Utherverse Digital to Utherverse Gaming on December 21, 2020.

6 **II. ASSISTANCE REQUIRED**

7 This request seeks assistance in obtaining documents from Brian Shuster, and in obtaining
 8 documents and testimony from Gary Shuster, Aaron Burch, and Utherverse Digital. This Court has
 9 jurisdiction under the Federal Rules of Civil Procedure to order discovery, including depositions of
 10 witnesses upon oral examination and production of documents from any person regarding any matter
 11 which is relevant to the subject matter of the pending action. This Court requests that the proper judicial
 12 authorities of British Columbia authorize legal process to compel these individuals to produce documents
 13 and/or provide deposition testimony as set forth below for potential use at trial in this litigation. The
 14 requests for specific documents and testimony are posed subject to any valid claim of privilege that these
 15 individuals may assert.

16 This Court further requests that the proper judicial authorities of British Columbia cause the
 17 depositions to be recorded in writing by a qualified court reporter, to cause the recordings of the
 18 depositions to be authenticated, to allow the depositions to be videotaped, and to cause the authenticated
 19 records to be delivered to Utherverse Gaming and Epic's counsel. It is hereby requested that Epic's
 20 representatives be granted the option to have the testimony videotaped by a qualified videographer. The
 21 original transcripts of the testimony, and if the testimony is videotaped, the videotapes, should be
 22 returned to Epic's representatives for retention and production at the time of trial.

23 **A. Relevance of Requested Materials and Testimony**

24 Messrs. Shuster and Burch are the only three named inventors on the Asserted Patents, who have
 25 been identified on Utherverse Gaming's Initial Disclosures as individuals who have information relevant
 26 to Utherverse Gaming's claims and defenses. Epic contends that as the sole inventors, Messrs. Shuster
 27 and Burch have key documents and information concerning the conception, reduction to practice, and
 28 scope of the claimed inventions, as well as the prosecution of the Asserted Patents, and that their

1 testimony and documents are likely to be central to trial in this action.

2 Utherverse Digital was the technology company for which the allegedly inventive work
 3 underlying the Asserted Patents was performed. Epic contends that Utherverse Digital therefore is
 4 likewise likely to have key documents and information concerning the conception, reduction to practice,
 5 and scope of the claimed inventions, the prosecution of the Asserted Patents as well as information
 6 concerning any systems or products embodying the Asserted Patents that were made, marketed, or
 7 attempted to be made or marketed by Utherverse Digital (which may be relevant to Epic's invalidity
 8 defenses at trial, as well as Utherverse Gaming's damages demand). Epic contends that Utherverse
 9 Digital is also likely to have information about the licensing of and/or attempts to license the Asserted
 10 Patents and related patents, the circumstances of the transfer or sale of the Asserted Patents to Utherverse
 11 Gaming, comparable licenses relevant to the damages analysis in this case, as well as any valuation of the
 12 Asserted Patents or inventions claimed therein that may have been performed in the course of
 13 prosecution, licensing, and sale or transfer of the patents. As employees and/or officers of Utherverse
 14 Digital at or around the time of invention, Messrs. Shuster and Mr. Burch may also have some of these
 15 documents and information in their individual capacities. Epic contends that these documents and
 16 testimony are important to establishing its claims and defenses at trial.

17 **B. Inability to Obtain Requested Materials and Testimony Without Judicial Assistance**

18 Under Federal Rule of Civil Procedure 30, because Mr. Brian Shuster is a managing agent of
 19 Utherverse Gaming, Utherverse Gaming must produce him for deposition on notice and without a
 20 subpoena. (Accordingly, this Request does not seek Mr. Brian Shuster's deposition.) However, though
 21 he is represented by Utherverse Gaming's counsel, he is not required to collect and produce documents in
 22 his possession, custody or control in his personal capacity in response to Epic's requests absent
 23 compulsory process, and Utherverse Gaming's counsel has indicated he will not do so. Mr. Brian
 24 Shuster being a Canadian resident, he is not readily subject to this Court's compulsory process for
 25 obtaining relevant documents.

26 Because Mr. Gary Shuster and Mr. Burch are not officers, directors, or managing agents, the
 27 Federal Rules of Civil Procedure do not provide a mechanism for Epic to obtain their depositions without
 28 a subpoena, and Utherverse Gaming's counsel (who also represent Mr. Shuster and Mr. Burch) have

1 indicated that they will not appear voluntarily. As with Mr. Brian Shuster, Mr. Gary Shuster and Mr.
 2 Burch are likewise not required to collect and produce documents in their personal possession, custody,
 3 or control absent compulsory process, and Utherverse Gaming's counsel has indicated they will not do
 4 so. Being Canadian residents, Mr. Gary Shuster and Mr. Burch are not readily subject to this Court's
 5 compulsory process for obtaining relevant documents and deposition testimony.

6 As a third party to this action, Utherverse Digital need not produce documents or a witness to
 7 testify on its behalf in this litigation without a subpoena, and Utherverse Gaming's counsel, who
 8 represents Utherverse Digital, has indicated that Utherverse Digital will not do so. As a Canadian
 9 corporation with no formal U.S. presence, Utherverse Digital is not subject to this Court's compulsory
 10 process for obtaining relevant documents and deposition testimony.

11 **C. Protection of Confidential Information**

12 This Court has entered a Protective Order in this Action, which is attached as Exhibit A-2 to this
 13 Request. The Protective Order enables those producing documents or providing testimony in this
 14 litigation, including third parties, to designate that material confidential and thereby obligate the
 15 receiving parties to comply with its terms against disclosure.

16 **D. Reciprocity**

17 Pursuant to 28 U.S.C. § 1782, this Court stands ready to extend similar assistance to the Courts of
 18 the Province of British Columbia in like cases.

19 **E. Reimbursement of Costs**

20 Epic, through its counsel at Durie Tangri LLP, are willing to provide reimbursement of
 21 reasonable costs incurred in executing this Letter Rogatory, if necessary and requested by the judicial
 22 authorities of Canada.

23 REQUESTS FOR DISCOVERY

24 This request calls for the production of documents in the possession or control of each witness as
 25 set forth below. This request also calls for each witness to provide deposition testimony concerning the
 26 topics set forth below. In the case of Utherverse Digital, this request calls for Utherverse Digital to
 27 designate a knowledgeable witness to provide deposition testimony on behalf of the company concerning
 28 the topics set forth below.

1 **F. DEFINITIONS**

2 The term “Asserted Patent” means any of United States Patent Nos. 8,276,071, 8,812,954,
3 9,123,157, and 9,724,605.

4 The term “Related Patent” means any patent that claims priority to an Asserted Patent or to any
5 patent or application to which an Asserted Patent also claims priority, or any foreign counterpart or
6 equivalent of an Asserted Patent.

7 **G. WITNESSES, DOCUMENTS, AND TOPICS**

8 **1. Brian Mark Shuster**
9 **2701-565 Smithe Street**
10 **Vancouver, BC V6B 0E4**

11 Documents are requested from Mr. Shuster as follows:

12 a. All documents concerning the conception, reduction to practice, development, or
13 testing of the alleged inventions described or claimed in the Asserted Patents.

14 b. All documents that evidence failings in the art preceding the conception and
15 reduction to practice of the alleged inventions described or claimed in the Asserted Patents.

16 c. All documents concerning the assignment of any right, title, or interest in any of
17 the Asserted Patents or Related Patents.

18 d. All documents concerning the sale of the Asserted Patents to Utherverse Gaming
19 LLC.

20 e. All communications with Utherverse Gaming LLC concerning any actual,
21 potential, contemplated, or proposed transaction or involving or relating to the Asserted Patents or
22 Related Patents.

23 f. All documents concerning any licenses to the Asserted Patents or Related Patents
24 or attempts to license the Asserted Patents or Related Patents.

25 g. All documents concerning any efforts to enforce the Asserted Patents or Related
26 patents, including via demand letter or litigation.

27 h. All documents concerning the prosecution of the patent applications from which
28 the Asserted Patents issued or to which they claim priority.

1 i. All documents relating to any assertion by any third party other than the U.S.
2 Patent and Trademark Office that an Asserted Patent or Related Patent is invalid, unenforceable, and/or
3 not infringed.

4 j. All documents relating to any “objective indicia of non-obviousness” applying to
5 the Asserted Patents, such as industry praise for the claimed invention, failure of others to create the
6 claimed invention, or commercial success of the claimed invention.

7 k. All documents concerning any efforts or plans to monetize the Asserted Patents or
8 Related Patents.

9 l. All documents concerning attempts by Mr. Shuster or Utherverse Digital, Inc. to
10 build or implement a product or system embodying or practicing any of the inventions claimed in the
11 Asserted Patents.

12 m. Documents sufficient to show the structure, function, and operation of any product
13 or system or contemplated product or system described in request [l].

14 n. Documents sufficient to show the commercial success or lack thereof of any
15 product or system described in request [l].

16 o. The results of any search for potential prior art to the Asserted Patents or Related
17 Patents.

18 p. All documents concerning any valuation (formal or informal) of the Asserted
19 Patents or Related Patents, alone or as part of a broader portfolio or broader transaction.

20 q. Documents sufficient to show Mr. Shuster’s financial interest in this litigation, if
21 any.

22 r. Documents sufficient to determine the amounts of money received by Mr. Shuster
23 as a result of any arrangement with Utherverse Gaming LLC concerning the Asserted Patents or Related
24 Patents.

25 **2. Gary Stephen Shuster**
26 **2705-1201 Marinaside Crescent**
27 **Vancouver, BC V6Z 2V2**

28 Documents are requested from Mr. Shuster as follows:

1 a. All documents concerning the conception, reduction to practice, development, or
 2 testing of the alleged inventions described or claimed in the Asserted Patents.

3 b. All documents evidencing failings in the art preceding the conception and
 4 reduction to practice of the alleged inventions described or claimed in the Asserted Patents.

5 c. All documents concerning the assignment of any right, title, or interest in any of
 6 the Asserted Patents or Related Patents.

7 d. All documents concerning the sale of the Asserted Patents to Utherverse Gaming
 8 LLC.

9 e. All communications with Utherverse Gaming LLC concerning any actual,
 10 potential, contemplated, or proposed transaction or involving or relating to the Asserted Patents or
 11 Related Patents.

12 f. All documents concerning any licenses to the Asserted Patents or Related Patents
 13 or attempts to license the Asserted Patents or Related Patents.

14 g. All documents concerning any efforts to enforce the Asserted Patents or Related
 15 patents, including via demand letter or litigation.

16 h. All documents concerning the prosecution of the patent applications from which
 17 the Asserted Patents issued or to which they claim priority.

18 i. All documents relating to any assertion by any third party other than the U.S.
 19 Patent and Trademark Office that an Asserted Patent or Related Patent is invalid, unenforceable, and/or
 20 not infringed.

21 j. All documents relating to any “objective indicia of non-obviousness” applying to
 22 the Asserted Patents, such as industry praise for the claimed invention, failure of others to create the
 23 claimed invention, or commercial success of the claimed invention.

24 k. All documents concerning any efforts or plans to monetize the Asserted Patents or
 25 Related Patents.

26 l. All documents concerning attempts by Mr. Shuster or Utherverse Digital, Inc. to
 27 build or implement a product or system embodying or practicing any of the inventions claimed in the
 28 Asserted Patents.

1 m. Documents sufficient to show the structure, function, and operation of any product
2 or system or contemplated product or system described in request [l].

3 n. Documents sufficient to show the commercial success or lack thereof of any
4 product or system described in request [l].

5 o. The results of any search for potential prior art to the Asserted Patents or Related
6 Patents.

7 p. All documents concerning any valuation (formal or informal) of the Asserted
8 Patents or Related Patents, alone or as part of a broader portfolio or broader transaction.

9 q. Documents sufficient to show Mr. Shuster's financial interest in this litigation, if
10 any.

11 r. Documents sufficient to determine the amounts of money received by Mr. Shuster
12 as a result of any arrangement with Utherverse Gaming LLC concerning the Asserted Patents or Related
13 Patents.

14 Testimony is requested from Mr. Shuster on the following topics:

15 a. The conception, reduction to practice, development, or testing of the alleged
16 inventions described or claimed in the Asserted Patents, and Mr. Shuster's role in or contribution to the
17 above.

18 b. Failings in the art preceding the conception and reduction to practice of the alleged
19 inventions described or claimed in the Asserted Patents.

20 c. The negotiation, circumstances, and terms of any assignment of any right, title, or
21 interest in any of the Asserted Patents or Related Patents.

22 d. Communications with Utherverse Gaming LLC concerning any actual, potential,
23 contemplated, or proposed transaction or involving or relating to the Asserted Patents or Related Patents.

24 e. The negotiation, circumstances, and terms of any licenses to the Asserted Patents
25 or Related Patents.

26 f. Any attempts to license the Asserted Patents or Related Patents.

27 g. Any efforts to enforce the Asserted Patents or Related patents, including via

1 demand letter or litigation.

2 h. Any efforts or plans to monetize the Asserted Patents or Related Patents.

3 i. The prosecution of the patent applications from which the Asserted Patents issued
4 or to which they claim priority.

5 j. Any assertion by any third party other than the U.S. Patent and Trademark Office
6 that an Asserted Patent or Related Patent is invalid, unenforceable, and/or not infringed.

7 k. Any “objective indicia of non-obviousness” applying to the Asserted Patents, such
8 as industry praise for the claimed invention, failure of others to create the claimed invention, or
9 commercial success of the claimed invention.

10 l. The nature of Utherverse Digital, Inc.’s business, Mr. Shuster’s role or
11 involvement in that business, an identification of any products and systems Utherverse Digital, Inc. has
12 made or marketed, and its success or lack thereof.

13 m. Attempts by Mr. Shuster or Utherverse Digital, Inc. to build or implement a
14 product or system embodying or practicing any of the inventions claimed in the asserted patents.

15 n. The structure, function, and operation of any product or system or contemplated
16 product or system described in request [l].

17 o. The commercial success or lack thereof of any product or system described in
18 request [l].

19 p. Any search for potential prior art to the Asserted Patents or Related Patents and the
20 results of that search.

21 q. Any valuation (formal or informal) of the Asserted Patents or Related Patents,
22 alone or as part of a broader portfolio or broader transaction.

23 r. Mr. Shuster’s financial interest in this litigation, if any.

24 s. The amounts of money received by Mr. Shuster as a result of any arrangement
25 with Utherverse Gaming LLC concerning the Asserted Patents or Related Patents.

26 3. **Aaron Burch**
27 **4041 Derby Court**
28 **Port Coquitlam, BC V3B6M3**

1 Documents are requested from Mr. Burch as follows:

2 a. All documents concerning the conception, reduction to practice, development, or
3 testing of the alleged inventions described or claimed in the Asserted Patents.

4 b. All documents evidencing failings in the art preceding the conception and
5 reduction to practice of the alleged inventions described or claimed in the Asserted Patents.

6 c. All documents concerning the assignment of any right, title, or interest in any of
7 the Asserted Patents or Related Patents.

8 d. All documents concerning the sale of the Asserted Patents to Utherverse Gaming
9 LLC.

10 e. All communications with Utherverse Gaming LLC concerning any actual,
11 potential, contemplated, or proposed transaction or involving or relating to the Asserted Patents or
12 Related Patents.

13 f. All documents concerning any licenses to the Asserted Patents or Related Patents
14 or attempts to license the Asserted Patents or Related Patents.

15 g. All documents concerning any efforts to enforce the Asserted Patents or Related
16 patents, including via demand letter or litigation.

17 h. All documents concerning the prosecution of the patent applications from which
18 the Asserted Patents issued or to which they claim priority.

19 i. All documents relating to any assertion by any third party other than the U.S.
20 Patent and Trademark Office that an Asserted Patent or Related Patent is invalid, unenforceable, and/or
21 not infringed.

22 j. All documents relating to any “objective indicia of non-obviousness” applying to
23 the Asserted Patents, such as industry praise for the claimed invention, failure of others to create the
24 claimed invention, or commercial success of the claimed invention.

25 k. All documents concerning any efforts or plans to monetize the Asserted Patents or
26 Related Patents.

27 l. All documents concerning attempts by Mr. Burch or Utherverse Digital, Inc. to
28 build or implement a product or system embodying or practicing any of the inventions claimed in the

1 Asserted Patents.

2 m. Documents sufficient to show the structure, function, and operation of any product
3 or system or contemplated product or system described in request [l].

4 n. Documents sufficient to show the commercial success or lack thereof of any
5 product or system described in request [l].

6 o. The results of any search for potential prior art to the Asserted Patents or Related
7 Patents.

8 p. All documents concerning any valuation (formal or informal) of the Asserted
9 Patents or Related Patents, alone or as part of a broader portfolio or broader transaction.

10 q. Documents sufficient to show Mr. Burch's financial interest in this litigation, if
11 any.

12 r. Documents sufficient to determine the amounts of money received by Mr. Burch
13 as a result of any arrangement with Utherverse Gaming LLC concerning the Asserted Patents or Related
14 Patents.

15 Testimony is requested from Mr. Burch on the following topics:

16 a. The conception, reduction to practice, development, or testing of the alleged
17 inventions described or claimed in the Asserted Patents, and Mr. Burch's role in or contribution to the
18 above.

19 b. Failings in the art preceding the conception and reduction to practice of the alleged
20 inventions described or claimed in the Asserted Patents.

21 c. The negotiation, circumstances, and terms of any assignment of any right, title, or
22 interest in any of the Asserted Patents or Related Patents.

23 d. Communications with Utherverse Gaming LLC concerning any actual, potential,
24 contemplated, or proposed transaction or involving or relating to the Asserted Patents or Related Patents.

25 e. The negotiation, circumstances, and terms of any licenses to the Asserted Patents
26 or Related Patents.

27 f. Any attempts to license the Asserted Patents or Related Patents.
28

1 g. Any efforts to enforce the Asserted Patents or Related patents, including via
2 demand letter or litigation.

3 h. Any efforts or plans to monetize the Asserted Patents or Related Patents.

4 i. The prosecution of the patent applications from which the Asserted Patents issued
5 or to which they claim priority.

6 j. Any assertion by any third party other than the U.S. Patent and Trademark Office
7 that an Asserted Patent or Related Patent is invalid, unenforceable, and/or not infringed.

8 k. Any “objective indicia of non-obviousness” applying to the Asserted Patents, such
9 as industry praise for the claimed invention, failure of others to create the claimed invention, or
10 commercial success of the claimed invention.

11 l. The nature of Utherverse Digital, Inc.’s business, Mr. Burch’s role or involvement
12 in that business, an identification of any products and systems Utherverse Digital, Inc. has made or
13 marketed, and its success or lack thereof.

14 m. Attempts by Mr. Burch or Utherverse Digital, Inc. to build or implement a product
15 or system embodying or practicing any of the inventions claimed in the asserted patents.

16 n. The structure, function, and operation of any product or system or contemplated
17 product or system described in request [l].

18 o. The commercial success or lack thereof of any product or system described in
19 request [l].

20 p. Any search for potential prior art to the Asserted Patents or Related Patents and the
21 results of that search.

22 q. Any valuation (formal or informal) of the Asserted Patents or Related Patents,
23 alone or as part of a broader portfolio or broader transaction.

24 r. Mr. Burch’s financial interest in this litigation, if any.

25 s. The amounts of money received by Mr. Burch as a result of any arrangement with
26 Utherverse Gaming LLC concerning the Asserted Patents or Related Patents.

27 **4. Utherverse Digital, Inc.
1040 Hamilton St., Suite 201
Vancouver, BC V6B 2R9**

1 Documents are requested from Utherverse Digital, Inc. as follows:

2 a. All documents concerning the conception, reduction to practice, development, or
3 testing of the alleged inventions described or claimed in the Asserted Patents.

4 b. All documents evidencing failings in the art preceding the conception and
5 reduction to practice of the alleged inventions described or claimed in the Asserted Patents.

6 c. All documents concerning the assignment of any right, title, or interest in any of
7 the Asserted Patents or Related Patents.

8 d. All documents concerning the sale of the Asserted Patents to Utherverse Gaming
9 LLC.

10 e. All communications with Utherverse Gaming LLC concerning any actual,
11 potential, contemplated, or proposed transaction or involving or relating to the Asserted Patents or
12 Related Patents.

13 f. All documents concerning any licenses to the Asserted Patents or Related Patents
14 or attempts to license the Asserted Patents or Related Patents.

15 g. Any patent license agreement to which Utherverse Digital, Inc. is a party.

16 h. All documents concerning any efforts to enforce the Asserted Patents or Related
17 patents, including via licensing demand or litigation.

18 i. All documents concerning the prosecution of the patent applications from which
19 the Asserted Patents issued or to which they claim priority.

20 j. All documents relating to any assertion by any third party other than the U.S.
21 Patent and Trademark Office that an Asserted Patent or Related Patent is invalid, unenforceable, and/or
22 not infringed.

23 k. All documents relating to any “objective indicia of non-obviousness” applying to
24 the Asserted Patents, such as industry praise for the claimed invention, failure of others to create the
25 claimed invention, or commercial success of the claimed invention.

26 l. All documents concerning any efforts or plans to monetize the Asserted Patents or
27 Related Patents.

28 m. All documents concerning any attempts by Utherverse Digital, Inc. to build or

1 implement a product or system embodying or practicing any of the inventions claimed in the Asserted
2 Patents.

3 n. Documents sufficient to identify any products to which Utherverse Digital Inc.
4 holds a license under the Asserted Patents.

5 o. Documents sufficient to show the structure, function, and operation of any product
6 or system or contemplated product or system described in requests [m] and [n].

7 p. Documents sufficient to show the commercial success or lack thereof of any
8 product or system described in requests [m] and [n].

9 q. The results of any search for potential prior art to the Asserted Patents or Related
10 Patents.

11 r. All documents concerning any valuation (formal or informal) of the Asserted
12 Patents or Related Patents, alone or as part of a broader portfolio or broader transaction.

13 s. Documents sufficient to show quarterly revenues, costs, profits, and losses
14 associated with any product made or marketed by Utherverse Digital, Inc. involving one or more
15 massively multiplayer online digital worlds.

16 t. Documents sufficient to show Utherverse Digital, Inc.'s financial interest in this
17 litigation, if any.

18 u. Documents sufficient to determine the amounts of money received by Utherverse
19 Digital, Inc. as a result of any arrangement with Utherverse Gaming LLC concerning the Asserted
20 Patents or Related Patents.

21 Testimony is requested from Utherverse Digital, Inc. concerning its corporate knowledge, if any,
22 on the following topics:

23 a. The conception, reduction to practice, development, or testing of the alleged
24 inventions described or claimed in the Asserted Patents.

25 b. Failings in the art preceding the conception and reduction to practice of the alleged
26 inventions described or claimed in the Asserted Patents.

27 c. The negotiation, circumstances, and terms of any assignment of any right, title, or
28

1 interest in any of the Asserted Patents or Related Patents.

2 d. Communications with Utherverse Gaming LLC concerning any actual, potential,
3 contemplated, or proposed transaction or involving or relating to the Asserted Patents or Related Patents.

4 e. The negotiation, circumstances, and terms of any licenses to the Asserted Patents
5 or Related Patents.

6 f. The negotiation, circumstances, and terms of any patent license agreement to
7 which Utherverse Digital, Inc. is a party.

8 g. Any attempts to license the Asserted Patents or Related Patents.

9 h. Any efforts to enforce the Asserted Patents or Related patents, including via
10 demand letter or litigation.

11 i. Any efforts or plans to monetize the Asserted Patents or Related Patents.

12 j. The prosecution of the patent applications from which the Asserted Patents issued
13 or to which they claim priority.

14 k. Any assertion by any third party other than the U.S. Patent and Trademark Office
15 that an Asserted Patent or Related Patent is invalid, unenforceable, and/or not infringed.

16 l. Any “objective indicia of non-obviousness” applying to the Asserted Patents, such
17 as industry praise for the claimed invention, failure of others to create the claimed invention, or
18 commercial success of the claimed invention.

19 m. The nature of Utherverse Digital, Inc.’s business, an identification of any products
20 and systems Utherverse Digital, Inc. has made or marketed, and its success or lack thereof.

21 n. Attempts by Utherverse Digital, Inc. to build, or implement a product or system
22 embodying or practicing any of the inventions claimed in the Asserted Patents.

23 o. An identification of any products to which Utherverse Digital, Inc. holds a license
24 under the Asserted Patents.

25 p. The structure, function, and operation of any product or system or contemplated
26 product or system described in requests [n] and [o].

27 q. The commercial success or lack thereof of any product or system described in
28 requests [n] and [o].

1 r. Any search for potential prior art to the Asserted Patents or Related Patents and the
2 results of that search.

3 s. Any valuation (formal or informal) of the Asserted Patents or Related Patents,
4 alone or as part of a broader portfolio or broader transaction.

5 t. The meaning and correct interpretation of any financial documents produced by
6 Utherverse Digital, Inc. in response to the above document requests.

7 u. The amounts of money received by Utherverse Digital, Inc. as a result of any
8 arrangement with Utherverse Gaming LLC concerning the Asserted Patents or Related Patents.

9 v. The extent to which Utherverse Digital, Inc. competes with Epic Games, the
10 market in which Utherverse Digital, Inc. competes with Epic Games, and the products with respect to
11 which Utherverse Digital, Inc. competes with Epic Games.

12 w. Utherverse Digital, Inc.'s financial interest in this litigation, if any.

13
14
15 Dated this 18th day of May, 2022



16
17 HONORABLE THERESA L. FRICKE
18 UNITED STATES MAGISTRATE JUDGE